

REMARKS

§103 rejections

In the 11 February 2008 Office Action, claims 64, 66-69, 71-73, 75, 77-80, 82-84, 86-91 and 93-95 are rejected under §103 as being unpatentable over Bielinski in view of "Outdated corporate reporting practices fail to measure companies' true value" in M2 Presswire (hereinafter, referred to as M2) and further in view of "Finance and economics: shining a light on company accounts" in The Economist (hereinafter, Economist). Claims 65 and 76 are rejected in view of Bielinski, M2, the Economist and "The use of options theory to value research in the service sector" by K Jensen and P. Warren (hereinafter referred to as Jensen). Claims 70, 74, 81, 85, 92 and 96 are rejected under §103 as being unpatentable over Bielinski, M2 and the Economist in view of Machine Learning Research – Four Current Directions by Thomas Diettrich (hereinafter Diettrich). The Assignee respectfully traverses the §103(a) rejections of claims 64 - 96 in a number of ways. First, by noting that the rejections fail under both standards of the APA and are therefore moot. Second by noting that the rejections are non-statutory. Third, by noting that the cited combination of documents fails to establish a prima facie case of obviousness in a number of ways, including:

1. failing to explain how the theoretical combination would be completed; and
2. failing to make the invention obvious by teaching away from the methods of the claimed invention.

The first way the cited combination of documents fails to establish a prima facie case of obviousness for claims 64-96 is by failing to explain the rationale for combining the teachings of the cited documents to replicate the functionality of the claimed invention. *The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (KSR, 550 U.S. at 1, 82 USPQ2d at 1396)."* In spite of this well know requirement, the Office Action has not described the rationale for combining the document teachings.

The second reason that claims 64-96 are patentable is that the cited combination fails to establish a prima facie case of obviousness because it teaches away from a number of claimed methods. MPEP § 2141.02 states that: "*in determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would*

have been obvious but whether the claimed invention as a whole would have been obvious (Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)).” Furthermore, it is well established that: *A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).* Examples of the cited combination teaching away from the claimed invention include:

- 1) Bielinski teaches the tree based analysis of cash flow in place of the regression models used in the instant application;
- 2) Bielinski teaches the efficient market theory which precludes the analysis of market sentiment taught by the instant application;
- 3) Bielinski teaches that cash flow is the determinant of value while the instant application teaches that value is the product of many factors including market sentiment, derivative value, investment value, real option value and cash flow;

Far from establishing a prima facie case of obviousness for claims 64 - 96, the cited combination of references in the 11 February 2008 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 11 February 2008 Office Action for claims 64 - 96 can be traversed.

§112 rejections

In the 11 February 2008 Office Action, claims 64-96 are rejected under §112 first paragraph for allegedly failing to describe the method of implementing the combination of activities described in the Markush Group. The Assignee respectfully traverses the §103(a) rejections of claims 64 - 96 in a number of ways. First, by noting that the rejections fail under both standards of the APA and are therefore moot. Second by noting that the rejections are non-statutory. Third, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. MPEP 2163 states that:

“A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the

written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:m(A) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description."

The arguments presented by the Examiner fail to establish the prima facie case required to sustain a §112 first paragraph rejection for a single claim because no evidence has been presented. As noted above, rejection under §112 first paragraph requires a preponderance of evidence and express findings of fact. In spite of this, no facts have been identified and no evidence has been presented about a specific concern regarding the specification. The Examiner has simply made a conclusory statement.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of the following copending U.S. Patent Application(s) which have claims pending that may be viewed as similar (with or without justification) to pending claims 64 – 96 of the instant application.

Application(s)	Pending claims that may viewed as being similar to claims 64 - 96	Summary of claims
09/764,068	36 – 63, 72 – 74 on appeal	Model of future or current enterprise market value by category of value, accounting
10/441,385	189 - 254	Element of value impact by category of value to market value or financial performance aspect
10/645,099	25 - 32	Element of value contribution by category of value to share price
10/746,673	64 - 96	Element of value contribution to segments of value

Applications 08/999,245, 09,761,670, 10/287,586 and 10/298,021 have claims related to element of value impact on a current operation. Application 10/097,344 has claims related to element of value impact on a current operation and to one or more real options. A copy of the most recent Office Actions and amendments for the above referenced applications have already been provided so no material is attached hereto.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the claims were amended was to put the application in final form for allowance and issue. The amendment that was made to one claim also obviates the 112 first paragraph rejection of claims 64 – 74.

Information Disclosure Statement

In accordance with the newly announced effort to reduce the number of disclosed references, the Assignee is making a diligent effort to reduce the number of “duplicate” reference documents and irrelevant reference documents that are submitted. Unfortunately, the Examiners for co-pending applications continue to produce references that appear to be irrelevant and/or appear to duplicate the teachings of reference documents that have already been submitted. This practice adds to the evidence of a skill deficit in TC 3600 and the U.S.P.T.O. Co-pending applications (see May 6, 2007 letter for a complete list) that have recently had apparently irrelevant or duplicate references produced by Examiners include: 10/012,375; 10/645,099; 10/743,616; 10/746,673 and 10/821,504. In many cases the Assignee is waiting for the Examiner(s) to identify the new and/or relevant teachings (if any) in the submitted reference documents before disclosing them in applications such as the instant application.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

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